

REMARKS

Claims 1-10 are in this application. Claim 1 has been amended to replace c) with b) and to change upto to up to. Claim 10 has been amended to replace c), d) and e) with a), b) and c) and to change upto to up to. Claim 2 has been cancelled. Claims 4 and 5 have been amended to depend from claim 10.

According to the Office Action Summary the drawing filed on 31 March 2004 is objected to. However, the examiner has not provided any reason for the objection.

According to the Office Action, claims 1-10 are rejected under 35 USC 112, first paragraph as failing to comply with the written description requirement because of the use of the phrase "up to 70% homologous" in the claims. This is rejection is respectfully traversed.

Support for the phrase "up to 70% homologous" is found on page 9, lines 7 and 11 of the specification. In addition, on pages 10 and 11 of the specification, it is explained that sequence variations to the extent of 30% may not affect the function of the TAM and TIM. Reference is made to US patent application 09/263,692 now US patent 6,639,065.

Although not binding on the examiner, it is noted that US patents 6,337,430; 6,054,574; 6,033,856; 6,083,717; and 6,093,569 include claims that include reference to homologous sequences. US patent 6,054,574 includes the following claims:

2. A DNA fragment as in claim 1, wherein said heat elements are at least 50% homologous to the Drosophila heat shock consensus sequence and function to increase expression of a gene under its control under heat shock conditions.

3. A DNA fragment as in claim 2, wherein said heat shock elements are at least 75 % homologous to the heat shock consensus sequence.

Therefore, it is respectfully requested that this rejection be withdrawn.

According to the Office Action, claims 1-10 are rejected under 35 USC 102(b) as being anticipated by Sawant et al. (Theor. Appl. Genet. 2001, Vol. 102, pages 635-644). This is respectfully traversed.

Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. *In re Paulsen*, 30 F.3d 1475, 31 USPQ 1671 (Fed. Cir. 1994). For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991).


The Sawant reference teaches unidirectional function of the TAM + TIM called at that time *Pcec*. The claims in this application define a bidirectional feature of TAM and the principle that TAM and its functional variants can be converted into a bi-directional promoter by placing a TIM on both sides of TAM. As these elements are not disclosed in Sawant, the claimed invention cannot be anticipated by this reference. Therefore, it is respectfully requested that this rejection be withdrawn.

According to the Office Action, claims 1-10 are rejected under 35 USC 102(3) as being anticipated by Tuli et al. (US patent 6,639,065) as evidenced by pUC19. This is respectfully traversed.

As the examiner notes Tuli has a common inventor with the instant application and that the rejection under 35 USC 102(e) might be overcome by a

showing under 37 CFR 1.131 or 37 CFR 1.132. The appropriate showing will be made.

Respectfully submitted,

A handwritten signature in black ink, appearing to be "Janet I. Cord", is written over a horizontal line. The signature is enclosed within a large, loopy oval shape.

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